



Express Mail Label No. EL985154115US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/862,636
Applicant : GOLDFAIN, et al.
Filed : May 22, 2001
Title : Eye Viewing Device Comprising Eyepiece and Video Capture Optics
TC/A.U. : 3737
Examiner : SANDERS JR., JOHN R.
Docket No. : 281-329.02
Customer No. : 20874

Confirmation No. 1483

#28

5-14

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Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

Declaration Under 37 C.F.R. § 1.68 of Cheryl Nichols

Sir:

I, Cheryl Nichols, was the Patent Docket Clerk for Wall Marjama & Bilinski LLP from May 2001 through December 2003. My duties as a Patent Docket Clerk included processing and electronically docketing all incoming patent-related correspondence. I hereby declare, under penalty of perjury, that a second Notice of Allowance (dated November 15, 2003) was not received in our office for the above-identified patent application.

I am fully aware that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. I have personal knowledge of the facts stated above and believe them to be true.

Date: May 4, 2004

By:


Cheryl Nichols

Customer No.: 20874
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Fax: (315) 425-9114



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Declaration Under 37 C.F.R. § 1.68 of Kathleen Mulligan-Piraino

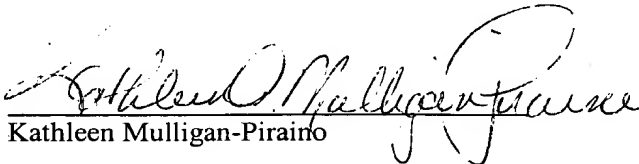
Sir:

I, Kathleen Mulligan-Piraino, have been the Patent Docket Clerk for Wall Marjama & Bilinski LLP since December 2003. My duties as a Patent Docket Clerk include processing and electronically docketing all incoming patent-related correspondence. I hereby declare, under penalty of perjury, that a second Notice of Allowance (dated November 15, 2003) has not been received in our office for the above-identified patent application.

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Date: May 4, 2004

By:


Kathleen Mulligan-Piraino

Customer No.: 20874
Telephone: (315) 425-9000
Fax: (315) 425-9114

PATENT CHRONOLOGICAL DOCKET

DueDate	ActionDue	Indicator	DateTaken	ActionType	Country	CaseNumber	AppNumber	FileDate	PatNumber	IssDate
11-Feb-2004	US-2 Month Offi Follow Up Date	Due Date	29-Aug-2003	US-2 Month Office Action	US	283_237.06	10/028.513	20-Dec-2001		
11-Feb-2004	US-3 Month Offi Follow Up Date	Due Date	02-Sep-2003	US-3 Month Office Action	US	905_063	10/308.549	03-Dec-2002	6,670,870	30-Dec-2003
12-Feb-2004	1 Month to Due Date	Reminder	28-Jan-2004	US-3 Month Office Action	US	205_060	10/287.866	06-Nov-2002		
12-Feb-2004	2 Month Reminder	Reminder		3.5 Year Maintenance Fee	US	093_006	09/473.178	28-Dec-1999	6,244,154	12-Dec-2000
12-Feb-2004	2 Weeks to Final Date	Due Date	29-Sep-2003	US-3 Month Office Action	US	210_498	10/165.125	07-Jun-2002		
12-Feb-2004	2nd Extension	Due Date	16-Oct-2003	US-Final Office Action	US	341_006	10/178.161	24-Jun-2002	6,708,359	23-Mar-2004
12-Feb-2004	2nd Extension	Reminder	24-Sep-2003	US-3 Month Office Action	US	210_537	10/278.261	23-Oct-2002	6,688,137	10-Feb-2004
12-Feb-2004	2nd Extension	Reminder	29-Oct-2003	US-Notice of Appeal	US	341_006	10/178.161	24-Jun-2002	6,708,359	23-Mar-2004
12-Feb-2004	Annulity - 2 mo Reminder	Reminder	23-Mar-2004	Annulity Due	CA	852_001	2,305,049	12-Apr-2000		
12-Feb-2004	Annulity Due (7th)	Due Date	05-Jan-2004	Annulity Due	CA	286_062	2,197,484	12-Feb-1997		
12-Feb-2004	Appeal Brief Due	Due Date	29-Oct-2003	US-Appeal Brief	US	341_006	10/178.161	24-Jun-2002	6,708,359	23-Mar-2004
12-Feb-2004	Chapter I Due (Extended)	Reminder	12-Sep-2001	Chapter I Due (Extended)	WO	281_335	01/287.83	12-Sep-2001		
12-Feb-2004	Chapter II Due (Nat'l Filing)	Reminder	12-Jan-2004	Chapter II Due (Nat'l Filing)	WO	281_335	01/287.83	12-Sep-2001		
12-Feb-2004	EP-request exam (reminder)	Due Date	20-Sep-2000	EP-request exam	EP	277_012	99/420179.6	12-Aug-1999		
12-Feb-2004	File Appl'n (reminder)	Due Date	05-Feb-2002	File Application in US PTO	US	210_265		13-Jan-2004		
12-Feb-2004	File Appl'n (reminder)	Due Date	13-Jan-2004	File Application in US PTO	US	210_504				
12-Feb-2004	Filing Due	Final	12-Feb-2004	File Application	US	555_020	60/447.218	12-Feb-2003		
12-Feb-2004	Filing Reminder	Reminder	12-Feb-2004	File Application	US	555_021	60/447.169	12-Feb-2003		
12-Feb-2004	For. Filing Lit to Client	Due Date	17-Mar-2004	Foreign Filing	US	283_319	60/470.016	12-May-2003		
12-Feb-2004	Foreign Filing Due	Due Date	12-May-2003	Foreign Filing Due	US	283_319	60/470.016	12-May-2003		
12-Feb-2004	Foreign Filing Due	Final	12-Mar-2003	Foreign Filing	WO	1153_002	03/04228	12-Feb-2002		
12-Feb-2004	Foreign Filing Due	Final	12-Feb-2004	Foreign Filing	US	555_020	60/447.218	12-Feb-2003		
12-Feb-2004	Foreign Filing Due	Final	12-Feb-2004	Foreign Filing	US	555_021	60/447.169	12-Feb-2003		
12-Feb-2004	Foreign Filing Reminder	Reminder	01-Apr-2004	Foreign Filing	US	283_248	10/436.182	12-May-2003		
12-Feb-2004	Supplemental IDS	Due Date	12-Feb-2004	Supplemental IDS	US	283_346.18	10/414.385	15-Apr-2003		
12-Feb-2004	US-3 Month Offi Follow Up Date	Due Date	03-Nov-2003	US-3 Month Office Action	US	283_237.06	09/988.360	20-Nov-2001		
13-Feb-2004	1st Opinion fro Follow Up Date	Due Date		1st Opinion from PCT	WO	1148_001	02/13496	29-Apr-2002		
13-Feb-2004	3 Month Due Date	Due Date	18-Dec-2003	US-3 Month Office Action	US	1036_001	10/356.239	31-Jan-2003		
13-Feb-2004	3 Month Due Date	Due Date	11-Feb-2004	US-3 Month Office Action	US	967_031	10/108.007	27-Mar-2002		
13-Feb-2004	7.5 year Main. Fee due	Due Date	05-Feb-2004	7.5 Year Maintenance Fee	US	1050_017	486,700	07-Jun-1990	5,544,893	13-Aug-1996
13-Feb-2004	Annulity - 2 mo Reminder	Due Date	09-Feb-2004	Annulity Due	JP	205_010	2-151760	12-Jun-1990	2,084,712	23-Aug-1996
13-Feb-2004	Annulity Due	Due Date		Annulity	GB	270_275	90/420075.5	13-Feb-1990	0383703	05-Oct-1994
13-Feb-2004	Annulity Due	Due Date	20-Jan-2004	Annulity Due	CA	905_075	2,335,895	13-Feb-2001		
13-Feb-2004	Annulity Due	Due Date	02-Feb-2004	Annulity Due	JP	702_035	7/1726/2	12-Jun-1990	2,605,159	13-Feb-1997
13-Feb-2004	Annulity Due	Due Date	12-Feb-2004	Annulity Due	EP	270_275	90/420075.5	13-Feb-1990	0383703	05-Oct-1994
13-Feb-2004	Application Status Check	Due Date	09-Jun-2003	Application Status Check	US	980_004	10/218.747	13-Aug-2002		
13-Feb-2004	Correct Priority Claim	Reminder	01-Mar-2003	Correct Priority Claim	WO	210_511	US03/36004	12-Nov-2003		
13-Feb-2004	Examination Rep Follow Up Date	Due Date	13-Aug-2003	Examination Report from PCT	WO	247_141	US02/11737	12-Apr-2002		
13-Feb-2004	Examination Rep Follow Up Date	Due Date	20-Aug-2003	Examination Report from PCT	WO	247_146	US02/11321	12-Apr-2002		
13-Feb-2004	Examination Rep Follow Up Date	Due Date	10-Oct-2003	Examination Report from PCT	WO	281_311.01	02/10540	03-Apr-2001		
13-Feb-2004	Final Response Follow Up Date	Due Date	13-Aug-2003	Final Response to Opinions	WO	281_337	02/11236	09-Apr-2002		
13-Feb-2004	Final Response Follow Up Date	Due Date			WO	281_311.02	US02/11235	09-Apr-2002		

PATENT CHRONOLOGICAL DOCKET

DueDate	Action/Due	Indicator	Date/Taken	Action/Type	Country	CaseNumber	AppNumber	FileDate	PatNumber	IssDate
13-Feb-2004	Final Response Follow Up Date	Due Date	13-Aug-2003	Final Response to Opinions	WO	961_002	02/20815	28-Jun-2002		
13-Feb-2004	Formal Drawings Due	Due Date	08-Dec-2003	US-Allowability	US	210_263	10/282,529	29-Oct-2002	6,701,726	09-Mar-2004
13-Feb-2004	Issue Fee Due	Final	15-Jan-2004	US-Allowance	US	210_263	10/282,529	29-Oct-2002	6,701,726	09-Mar-2004
13-Feb-2004	Maintenance fee ltr to client	Due Date	12-Mar-2004	3.5 Year Maintenance Fee	US	269_037	09/364,387	30-Jul-1999	6,187,184	13-Feb-2001
13-Feb-2004	Tax 7.5	Due Date	05-Feb-2004	Tax 7.5	US	1050_017	486,700	07-Jun-1995	5,544,893	13-Aug-1996
13-Feb-2004	Tax 7.5 Follow Up Date	Due Date	13-Aug-2003	Tax 7.5	US	1005_001	08/029,139	10-Mar-1993	5,490,292	13-Feb-1996
13-Feb-2004	Translation/pymt of fees	Due Date	13-Aug-2003	Translation/pymt of fees	EP	283_230	98/107,165.7	20-Apr-1998		
13-Feb-2004	US-3 Month Off Follow Up Date	Due Date	13-Aug-2003	US-3 Month Office Action	US	905_075	09/725,525	29-Nov-2000	6,674,289	06-Jan-2004
13-Feb-2004	US-Publication Fee Due	Due Date	15-Jan-2004	US-Publication Fee Due	US	210_263	10/282,529	29-Oct-2002	6,701,726	09-Mar-2004
13-Feb-2004	Verify Issue Notification	Due Date	11-Sep-2003	US-Allowance	US	905_090	09/844,016	27-Apr-2001	6,628,487	30-Sep-2003
14-Feb-2004	Verify Issue Notification	Due Date	20-Oct-2003	US-Allowance	US	1178_001	09/076,553	12-May-1998		
14-Feb-2004	1st Ext (Appeal Brief)	Due Date	10-Feb-2004	US-Appeal Brief	US	1223_002	09/591,313	09-Jan-2000		
14-Feb-2004	1st Extension	Reminder	05-Feb-2004	US-3 Month Office Action	US	1153_010	10/003,851	02-Nov-2001		
14-Feb-2004	1st Extension (Appeal Brief)	Reminder	14-Jan-2004	US-Appeal Brief	US	977_008	09/140,506	26-Aug-1998		
14-Feb-2004	4th Extension	Reminder	10-Oct-2003	US-Missing Parts	US	965_020	10/463,457	17-Jun-2003		
14-Feb-2004	6 Month Final	Final	26-Sep-2003	US-3 Month Office Action	US	245_331	09/387,009	31-Aug-1999		
14-Feb-2004	Annulity - 2 mo Reminder	Reminder	24-Mar-2004	Annulity Due	EP	852_001	00/303,197.8	14-Apr-2000		
14-Feb-2004	Annulity - 2 mo Reminder	Reminder	03-Apr-2004	Annulity Due	CA	832_001	2,267,604	14-Apr-1999	2,267,604	08-Jul-2003
14-Feb-2004	Final Deadline	Final	12-Aug-2003	US-Missing Parts	US	283_346.18	10/414,385	15-Apr-2003		
14-Feb-2004	Foreign Filing Due	Due Date	13-Feb-2004	Foreign Filing	US	647_014	10/367,585	14-Feb-2003		
14-Feb-2004	Foreign Filing Reminder	Reminder	16-Mar-2004	US-Allowance	US	507_003.04	10/438,305	14-May-2003		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_170	29/182,201	21-May-2003		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_175	29/181,361	09-May-2003		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_178	29/181,693	14-May-2003		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_179	29/186,428	15-Jul-2003		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_171	29/181,362	09-May-2003	D489,580	11-May-2004
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_172	29/181,365	09-May-2003	D489,581	11-May-2004
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_173	29/181,403	09-May-2003	D489,944	18-May-2004
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_174	29/181,371	09-May-2003	D489,943	18-May-2004
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_176	29/181,358	09-May-2003	D489,942	18-May-2004
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_177	29/181,358	05-Oct-2001		
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_178	29/181,358	09-Oct-2001		
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14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_172	29/181,365	21-May-1999		
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14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_177	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_178	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_179	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_171	29/181,362	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_172	29/181,365	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_173	29/181,403	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_174	29/181,371	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_176	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_177	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_178	29/181,358	16-Sep-1998	2,135,946	24-Apr-1998
14-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-20							

PATENT CHRONOLOGICAL DOCKET

DueDate	ActionDue	Indicator	DateTaken	ActionType	Country	CasestNumber	AppNumber	FileDate	PatNumber	IssDate
15-Feb-2004	Deadline to file Follow Up Date	Due Date	15-Aug-2003	Deadline to file HK	CN	283_263	00815975.0	04-Oct-2000		
15-Feb-2004	File Appl'n	Due Date		File Application in US PTO	US	1245_001				
15-Feb-2004	Final Deadline	Due Date		File Application in US PTO	US	205_114				
15-Feb-2004	For. Filing Ltr to Client	Final	08-Sep-2003	US-Missing Parts	US	507_003.04	10/438,305	14-May-2003		
15-Feb-2004	For. Filing Ltr to Client	Due Date	29-Apr-2003	Foreign Filing	US	281_344.03	29/179,826	15-Apr-2003		
15-Feb-2004	Foreign Filing Follow Up Date	Due Date	08-Mar-2004	Foreign Filing	US	283_346.18	10/414,385	15-Apr-2003		
15-Feb-2004	Instructions to Follow Up Date	Due Date	15-Aug-2003	Foreign Filing	US	905_151	09/897,319	29-Jun-2001	6,683,251	27-Jan-2004
15-Feb-2004	Issue Fee Due in 2 Months	Due Date	15-Aug-2003	Instructions to Assoc.	EP	283_237.08	99/953,395.3	28-May-1999		
15-Feb-2004	Issue Fee Due in 2 Months	Reminder	16-Mar-2004	US-Allowance	US	255_177	29/181,360	09-May-2003		
15-Feb-2004	Response to Ass Follow Up Date	Reminder	14-Apr-2004	US-Allowance	US	283_173.01	10/201,224	22-Jul-2002		
15-Feb-2004	Tax 3.5	Due Date	15-Aug-2003	Response to Assoc.	EP	283_237.08	99/953,395.3	28-May-1999		
15-Feb-2004	Tax 3.5	Due Date	15-Aug-2000	Tax 3.5	US	210_150	09/237,491	25-Jan-1999	6,101,839	15-Aug-2000
15-Feb-2004	Tax 3.5	Due Date	11-Feb-2004	Tax 3.5	US	905_065	09/275,322	24-Mar-1998	6,102,713	15-Aug-2000
15-Feb-2004	Tax 3.5	Due Date	11-Feb-2004	Tax 3.5	US	905_153	09/132,070	17-Aug-1998	6,102,360	15-Aug-2000
16-Feb-2004	1 Month to Due Date	Reminder	15-Mar-2004	US-3 Month Office Action	US	1223_009	10/274,677	18-Oct-2002		
16-Feb-2004	2nd Extension	Due Date	07-Nov-2003	US-Final Office Action	US	210_503	10/189,116	02-Jul-2002		
16-Feb-2004	2nd Extension	Reminder	07-Nov-2003	US-Notice of Appeal	US	210_503	10/189,116	02-Jul-2002		
16-Feb-2004	Appeal Brief Due	Reminder	16-Dec-2003	US-3 Month Office Action	US	1223_005	10/210,708	31-Jul-2002		
16-Feb-2004	Application Status Check	Due Date	07-Nov-2003	US-Appeal Brief	US	210_503	10/189,116	02-Jul-2002		
16-Feb-2004	Fee Due in 1 Month	Reminder	01-Mar-2004	US-Allowance	US	210_499	10/222,389	16-Aug-2002		
16-Feb-2004	Foreign Filing Reminder	Due Date	16-May-2003	Foreign Filing	US	977_018	10/278,356	23-Oct-2002	6,721,993	20-Apr-2004
16-Feb-2004	Maintenance fee ltr to client	Due Date		11.5 Year Maintenance Fee	US	256_015	07/777,887	04-Oct-1991	5,186,007	16-Feb-1993
16-Feb-2004	PCT - Chap VIII Ltr to Client	Due Date	16-Feb-2004	PCT - Chap VIII Ltr to Client	WO	1148_001	02/13496	29-Apr-2002		
16-Feb-2004	Request exam (reminder)	Reminder	01-Mar-2004	US-Publication Fee Due	US	210_543	10/278,356	23-Oct-2002	6,721,993	20-Apr-2004
17-Feb-2004	1st Extension	Due Date		Deferred Examination	CA	277_013	2,280,411	16-Aug-1999		
17-Feb-2004	2 Month Reminder	Reminder	17-Mar-2004	US-3 Month Office Action	US	977_026	09/273,304	19-Mar-1999		
17-Feb-2004	2 Month Reminder	Due Date	16-Jan-2004	US-1 Month Office Action	US	283_205.06	10/227,889	26-Aug-2002		
17-Feb-2004	2nd Extension	Reminder	16-Mar-2004	7.5 Year Maintenance Fee	US	1050_014	580,283	27-Dec-1995	5,584,486	17-Dec-1996
17-Feb-2004	2nd Extension	Reminder	15-Dec-2003	US-3 Month Office Action	US	1050_015	328,498	25-Oct-1994	5,584,485	17-Dec-1996
17-Feb-2004	3 Mo Response Due (Final OA)	Reminder	17-Dec-2003	US-3 Month Office Action	US	977_011	09/687,804	22-Jun-2001		
17-Feb-2004	3 Mo. Due - Notice of Appeal	Due Date	17-Dec-2003	US-Final Office Action	US	281_340	10/051,811	16-Jan-2002		
17-Feb-2004	3 Month Reminder	Due Date	17-Dec-2003	US-Notice of Appeal	US	210_574	09/972,502	09-Oct-2001		
17-Feb-2004	Advisory Action	Reminder		11.5 Year Maintenance Fee	US	1067_001	537,262	09-Oct-2001		
17-Feb-2004	Annulity - 3 mo Reminder	Due Date		US-Final Office Action	US	210_574	09/972,502	13-Jun-1990	5,163,889	17-Nov-1992
17-Feb-2004	Annulity Due	Reminder		Annulity Due	CA	482_001	2,162,464	09-Oct-2001		
17-Feb-2004	Final Deadline	Due Date	27-Aug-2003	US-Missing Parts	EP	281_261	98/420,031.1	17-May-1994		
17-Feb-2004	For. Filing Ltr to Client	Due Date	17-Oct-2003	Foreign Filing	US	210_611	10/443,481	17-Feb-1998		
17-Feb-2004	IDS Reminder	Due Date	17-Dec-2003	Information Disclosure Stmt	US	977_033	10/417,533	22-May-2003		
17-Feb-2004	Missing Parts due	Due Date	19-Feb-2004	US-Missing Parts	US	212_057	10/738,659	17-Apr-2003		
17-Feb-2004	Missing Parts due	Due Date	19-Feb-2004	US-Missing Parts	US	283_392.11	10/669,896	17-Dec-2003		
17-Feb-2004	Missing Parts due	Due Date	19-Feb-2004	US-Missing Parts	US	283_392.12	10/669,894	23-Sep-2003		

1971 WL 16674 (D.D.C.)

Delgar Inc. et al.

v.

Schuyler, Comr. Pats.

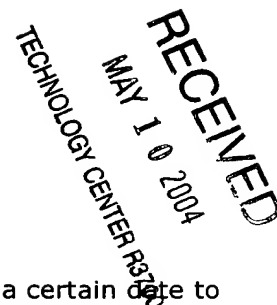
District Court, District of Columbia

No. 1904-70

Decided Dec. 22, 1970, and Jan. 4, 1971



United States Patents Quarterly Headnotes



PATENTS

[1] Abandonment - Application (§ 10.3)

Fees - Patent Office (§ 37.7)

Pleading and practice in Patent Office - In general (§ 54.1)

Although Patent Office records show that notice of allowance was mailed on a certain date to applicant's attorney, and although fee was not paid as required by 35 U.S.C. 151, court grants summary judgment authorizing Office to issue a new notice of allowance inasmuch as attorney allegedly did not receive first notice.

***513** Action by Delgar Inc., Robert Gardel, and Egon Gorsky against William E. Schuyler, Jr., Commissioner of Patents. Summary judgment for plaintiffs.

George R. Douglas, Jr., and Misegades & Douglas, both of Washington, D. C., and Nolte & Nolte, A. C. Nolte, Jr., Edward B. Hunter, and Evelyn M. Sommer, all of New York, N. Y., for plaintiffs.

S. Wm. Cochran and J. F. Nakamura for defendant.

Pratt, District Judge.

Mr. Nakamura: If the Court please, this case is a patent case. It involves Section 151 of the Patent Statute. Section 151 provides that a written notice of allowance shall be mailed to the applicant. This notice of allowance calls for payment of an issue fee. If that issue fee is not paid within six months, the application is regarded as irrevocably abandoned by operation of the statute. Now, in the present case, the record shows that such a notice of allowance was mailed. The issue fee was not paid within the six months.

The application, therefore, in the eyes of the Patent Office, stands abandoned by operation of the statute.

Now, plaintiffs' claim for relief is based solely on their allegation that no notice of allowance was received by their attorneys.

We submit that the statute provides no basis for relief.

First of all, Section 151 does not expressly require that a notice of allowance be received by the applicant. In Section 151 there appears only the term "mail a written notice" -

The Court: Is there any provision for publication of allowances?

Mr. Nakamura: No, Your Honor, there is not.

The Court: Are they customarily published?

Mr. Nakamura: No, they are not customarily published. The notice is mailed. In the great majority of the cases, it is received. Occasionally it is not, for one reason or the other.

In this case the applicant has only alleged that it has not been received.

Now, there is a long-standing construction of the term "mail" in the Patent Office. This is a construction which excludes receipt. This is a construction which dates back at least 50 years, and long prior to the enactment of Section 151, which was enacted in 1965.

I can show Your Honor representative decisions that have been handed down by past Commissioners, Ex parte Lacey, for example, in 1920 C.D. 83, and Ex parte Glake in 1906 C.D. 159.

The Court: I take it that in this case there was a petition filed with the Commissioner?

Mr. Nakamura: That is correct, Your Honor.

If Your Honor would care to see the wording of Section 151, I have a copy of that statute here, which I am prepared to hand up.

The Court: It says that they provide for a sum constituting the issue fee, or a portion thereof, which

shall be paid within three months thereafter. Upon payment of this sum, the patent shall issue. If payment is not timely made, the application shall be regarded as abandoned.

Mr. Nakamura: That is correct.

The Court: Then it says that any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof.

Is that the notice of allowance?

Mr. Nakamura: The first one is the notice of allowance. It contains an estimated issue fee.

The Court: The second notice that they are talking about is the notice that more money is due, I take it?

Mr. Nakamura: That is correct; if the printing exceeded the estimate.

The Court: Yes.

The Court: Has this type of situation ever been litigated before in court?

Mr. Nakamura: To my knowledge, Your *514 Honor, it has not. This is the first time that the question has arisen.

The Court: Now, what you have just shown me is the statute, itself, is that correct?

Mr. Nakamura: This is the statute, itself, that is correct, Your Honor.

The Court: All right, I will hear further from you, if you like.

Mr. Nakamura: Your Honor, we submit that under normal rules of statutory construction, there being no legislative intent to include receipt in the term "mailing," that the defendant has no authority to read the term into the statute in the light of the past construction of "mail" in the situation with which we are now concerned.

The Court: What is involved in resurrecting a patent which has been put in an abandoned category? Do you have to file all over again?

Mr. Nakamura: Yes. If the applicant is willing to forego the benefit of having the earlier date, the date of his earliest application, then he can file at any time.

As in this particular case, if he filed today, the application would date from today.

The Court: What does this patent cover?

Mr. Nakamura: This is a patent on a doll, Your Honor. I believe, Your Honor, before I leave, I would like to point out that there is a drawing which accompanies the patent application. It is in the file. It is a part of Exhibit A, accompanying the defendant's motion to dismiss.

The Court: Did you file a response to the motion to dismiss?

Mrs. Sommer: Yes, we did, Your Honor. We filed an opposition to the motion to dismiss.

First, I would like to sort of point out the sequence that this case went through in the Patent Office, mostly because I think that it is very interesting.

The application was filed in December, 1965, and went through a normal course of prosecution up to the filing of notice of appeal and a brief upon appeal.

Sometime in October, specifically October 9, 1968, the examiner who was prosecuting the application called a Mr. W. S. Seward, who was a partner in Nolte & Nolte, and who was the attorney who was handling the application, and advised him that he was going to allow the case. That was October 9, 1968.

On October 10, 1968, the Patent Office sent out a paper, which is Paper 14 in this case, in which the Patent Office indicated that the prosecution in the case was closed and that a notice of allowance would shortly be forwarded. This is an official form of the Patent Office.

That form, which is Form P.O.L. 255, as I said, was mailed 10/10/68, and was addressed to Nolte and Nolte.

On that very same day another paper went out from the Patent Office, which was mailed to another address. It was mailed to the firm of Brown & Seward at 11 Park Road, New York City. That very day, two papers were mailed from the Patent Office: One, the form P.O.L. 255; the other, a Form 19. Both going to different addresses.

Thereafter, another paper was mailed from the Patent Office, this being Paper Number 15 and Form P.O.L. 37. This paper carries the date January 29, 1969, and this form is what is known as a Notice of Examiner's Amendment.

This form says pretty much the same thing. It indicates some amendments that the examiner is entering pursuant to a conference had with Mr. Seward on 10/10/68, and says a notice of allowance will be forthcoming.

I think that this paper, which was addressed to Nolte and Nolte at 330 Madison Avenue, is interesting, because it carries not only the notation that the paper was typed on 10/31/68, but it was mailed on January 29, 1969.

I would like to point out that I mentioned that one paper was mailed to another address in this period. Two additional papers were mailed to Brown and Seward at 11 Park Road.

The Court: Who was the attorney for the applicant?

Mrs. Sommer: Originally, attorneys of record were Brown and Seward. During the prosecution, an associate power of attorney was filed, making Nolte and Nolte the attorneys of record.

I would like to point out, for example, that when notice of appeal was filed in this case, the notice of appeal carries an express written-typed notice which says:

All correspondence is to be addressed to Nolte and Nolte, 330 Madison Avenue.

The very next paper which was mailed by the Patent Office, which is what we call the appeal receipt, that gives the appeal number and which was mailed within about a week of that date, is mailed to Brown and Seward at 11 Park Road.

Despite the fact that the notice of appeal carries the express note: All correspondence to go to Nolte and Nolte, the appeal receipt was mailed to Brown.

So, we have a course of conduct throughout of the Patent Office's sending correspondence to different addresses.

Fortunately, the mail was rerouted by the Patent Office and the papers that I am referring *515 to were received in the Office of Nolte and Nolte at 330 Madison Avenue.

I also want to point out-because the Patent Office made a big issue of the fact that notices of allowance are typed on one day and they carry the next mailing day and they are mailed out. It is presumed that they are mailed out on the next day-that the form P.O.L. 255, which I mentioned before, carries the typing date 10/31/68 and was mailed January 29, 1969. In other words, some three months later, this was mailed out of the Patent Office.

Mr. Nakamura, counsel for the Patent Office, mentioned that the rule which is involved, or the statute which is involved, is 35 U.S.C. 151, and that this requires that the notice of allowance be mailed.

Specifically, the statute says, "Mailed or given."

I have a copy of the statute here and the patent laws. It says, "If it appears that the applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant."

In other words, I think that it connotes a little bit more than just putting it in the mailbox. It connotes that it is either given or mailed. In other words, both terms appear in the statute.

Furthermore, the Patent Office has promulgated its own rules in connection with notice of allowance. And the rule is a little different than the Patent Office and puts a stricter construction-I am sure that I have the rule-yes. The rule which is involved, and this is from the Patent Office Rules, is Rule 311, and it is noted under "Notice of Allowance: If upon examination it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him."

If the word "sent" is looked up in the dictionary-and we mentioned this in some of the papers-it indicates more than mailed. It indicates that it is going to be received.

Also, in connection with mail given or sent, Mr. Nakamura cited some cases.

We would like to point out that this very court, the District of Columbia, has, in a decision, Creasy versus the United States, and that is 4 F.Supp. 175, D.C.-Va. 1933, expressly set out that there is no notice unless it is received.

In other words, just merely putting it in the mail is not notice. The notice must be received.

The Court: Mrs. Sommer, did you receive the January 29th letter, that is January 29, 1969, that the application was being passed to issue by the examiner?

Mrs. Sommer: Yes, sir, we did.

The Court: What did you do when you got that?

Mrs. Sommer: We got that. I happen to have a copy of the correspondence here with me. Mr. W. S. Seward, who was a partner in the firm of Nolte and Nolte, was handed that in the course of-in other words, the mail is opened in a very specific manner. The papers are entered and a record is made of all mail that is received. If there is anything that the applicant must do-in other words, if there is anything that we have to do, the office has to do-it is entered onto the outside of a file, and on the outside of the file, the date that the thing came in and the date for response appears.

Nothing appears on this outside of this file after the fact that an appeal brief was entered. There was an amendment also entered, which also appears.

There is no indication of notice of allowance receipt, because it was never received.

The Court: Is there any indication that the January 29th letter was received?

Mrs. Sommer: No; the only indication is that we have it and have the letter written by Mr. Seward,

in which he advised the client that this notice had been received. There is nothing for the applicant to do when that is received.

The Court: What is the normal time span between this kind of a communication and the receipt of the notice of allowance?

Mrs. Sommer: Well, we have cited a case in this case. The patent is Tran Van Khai Patent. I have the number. It is Number 3498764. An instance there was 13 days.

We have also mentioned patent applications in our own file, where it has gone up to eight months. There is no statutory requirement that we inquire.

In other words, if a normal office action is received that there has been a notice promulgated by the Patent Office which says that within two months if nothing has happened you should write a status letter.

There is no requirement with respect to this notice that a patent will be issued on inquiring.

The Court: Don't most people, when they do not get the notice of allowance, promptly get on the telephone or write a letter or do something about inquiring about where it is.

Mrs. Sommer: I would say no.

In the same file, Tran Van Khai, which we referred to, the same procedure arose, and it is not conventional to inquire. Not in this.

The Court: It is my experience in dealing with the Government that if you know a letter ***516** is coming and you do not get it, you get on your horse.

Mrs. Sommer: We are now inquiring at the end of two months.

The Court: It does not matter whether it is the Patent Office, or any other branch of Government: The Federal Power Commission, the Federal Communications Commission, Internal Revenue, any of these. If you know that something is going to happen and it does not happen and you have not received it, why, I think it is par for the course to call up and say: Look, we missed something.

Mrs. Sommer: Well, I have to admit that previous to this we had in some cases the attorney would keep a record. Then he would inquire. But it was no general rule. We now have the general rule in the office that the Docket Clerk inquires at the end of two months.

I wanted to make another point in this case: There are a number of decisions in which this same issue came up, where the notice of allowance allegedly was not received. These decisions are in no way made public. In other words, they have not been published. This Tran Van Khai Case I referred to.

Mr. Nakamura served Mr. Douglas yesterday with a paper, Opposition by Defendant to Plaintiffs' Motion for Summary Judgement, in which a noted decision is mentioned, in which, in fact, the decision appears as Exhibit C, all going to this point of late payment of final fee.

And there is another one. I have the Patent Application Number. I do not have the number of the issued patent.

None of these decisions have ever been published by the Patent Office, by the agency. There is no record of them.

We would like to point out, therefore, that these decisions can not be relied upon, whether they are positive or negative, really, by the Patent Office, since there has been no notice, as is required by the Administrative Act and by the Public Information Section of the Administrative Act, which says that, specifically 552 under 2 (a), that each agency, in accordance with published rules, shall make available for public inspection a copy (a) a final opinion; (b) those statement of policy and interpretations which have been adopted by the agency and are not published by the Federal Register, so on and so forth. None of these decisions. There is a large number of them. We have referred to three right here. We can mention three right here. One of which for the first time I saw this morning, because I saw these opposition papers this morning. Two of which were obtained for us by Mr. Douglas through personal contacts.

In other words, you would never know that the Commissioner had decided favorably, and had decided favorably in the Tran Van Khai Case, which is the exact same as the instant case; the exact same facts existant that Commissioner Reynolds decided in October 1969, I believe it was, that another notice of allowance would be forthcoming.

His decision is very simple. He says: On the facts in the case. His decision is dated October 30, 1969. It is in the file of U. S. Patent 3498764. He says: The renewed petition filed October 17, 1969, for the acceptance of a final fee in the above-entitled application has been considered. On the basis of the entire record, as now presented, it is thought proper to hold that a notice of allowance of the application was not duly mailed on November 15, 1968. Accordingly, the present action is to be treated as such a notice of allowance. Since the issue fee was paid on July 10, 1969, the patent will

be issued in due course. The petition is granted to the extent indicated.

There is another one where the exact situation arose. Again Commissioner Reynolds issued the patent.

In other words, the Commissioner has, in situations which parallel this case on all fours, subsequently permitted the payment of the final fee which was due and issued a notice of allowance. The loss of a patent. I do not believe that it is germane to the issue, but we mentioned that this is a patent for a doll; specifically, it is for a walking doll, and a very important doll.

This application form has licenses all over the world.

In other words, I do not want to mention the assignee, because that gets into particulars which are not germane.

This is a very commercial patent; extremely important.

If the patent does not issue, we are now in the situation where there is really nothing under the recent decisions on know how and secret information, and so on. There is nothing left.

This patent has issued. For example, there are corresponding patents in other countries in the world. There is for sure I know in Germany. I am not sure of the other countries. As I say, it has been licensed all over the world.

The applicants have exhausted their remedy in the Patent Office and have filed petitions, renewed petitions, all of which have been denied by Assistant Commissioner Kalk on the grounds, first of all, that the statute prevents him from acting otherwise.

I just pointed out at least two cases where Assistant Commissioner Reynolds has also, as ***517** an arm of the Patent Office, decided differently.

Also, the Patent Office feels that just mailing it and putting a copy of the notice of allowance with the word "mailed" on it is all that the Patent Office has to prove.

We have set out in considerable detail what the Patent Office does with respect to mailing a notice of allowance.

Number One, they send it to a typist, who types it on the day before it is dated. The typist in our case would have typed it. In all cases, it is universal procedure. Types it on one day, but types in another date. The thing is then sent to the mail room, and presumably is mailed out from the mail room. No record of it is made in the mail room; of its receipt in the mail room or of its actual mailing.

Any record which is entered into the file is entered from a card or tape which is made in the Notice of Issue Branch; not from the mail room.

So, we, as in *Tran Van Khai*, where they were sustained, where the appellant was sustained, do not believe that the Patent Office can rely on their saying that they just mailed it and that they have a record that they mailed it.

I pointed out in one case where they say that it was typed on one day and mailed three months later, in our own file. This presumably was typed one day and mailed the next day. It was never received in our office. There is no record of it anywhere.

I also want to point out that Mr. Nakamura said that usually these things are received. But there are instances where they are not received; where they are not correctly addressed, or misdirected, or who knows what, and get into the wrong office.

We do not feel that we have to establish that. We just have to prove that we never received it. It was never received in the office.

Inquiry was made at the Patent Office in connection with the prosecution of another application in another country, a corresponding application in another country.

Mr. Seward, who was handling it-I remember, it was Loudon against the United States-he went and got the United States' file and saw that there was no notice of allowance. Then immediately the petition was filed.

The Court: Mr. Nakamura.

Mr. Nakamura: If I may, Your Honor, I would like to add some comments in rebuttal here.

First of all, with reference to these decisions in other patents which Mrs. Sommers has referred to, and with reference, also, to her argument with respect to the Administrative Procedure Act, I would like to point out this: That these two decisions that she mentioned are in the patent files. As such, they are available to the public.

Now, it is true that we have not indexed them. But as Your Honor will appreciate from the number of cases which have come up on this point, it apparently would be a burden on the Patent Office to index such decisions.

Now, with respect to the first of those cases, the *Tran Van Khai* Case, I believe, is mentioned by Mrs.

Sommer.

I would like to point out this fact, that the attorney in that case complained not only that he did not receive the notice of allowance, but he also complained that the firm was not shown correctly in the address.

So, in this case there was some possible indication that the Patent Office had not very properly mailed the notice of allowance.

The Court: Mr. Nakamura, the reason that Mr. Reynolds accepted the final fee in the Tran Van Khai Case was because of the fact that he was satisfied that the notice of allowance had not been received; is that not true?

Mr. Nakamura: Had not been duly mailed, Your Honor. I believe that was the comment.

The Court: He said not duly mailed?

Mr. Nakamura: Not duly mailed.

If one looks to the reasons that supported the attorney's petition-in my copy here, it would be on the 4th page, after the decision of Commissioner Reynolds; then the next to the last sentence of the petitioner says: If the Patent Office actually mailed a notice of allowance in the present case, how can it be so sure that it was mailed to the applicant's attorney, as 35 U.S.C. 151 requires, especially when it is ruled that the Patent Office copy of the notice of allowance did not even show the attorney's name correctly.

[1] The Court: In this case, your own record shows that notice of allowance was mailed on a certain date?

Mr. Nakamura: Yes, it does, Your Honor.

The Court: It shows to whom it was mailed?

Mr. Nakamura: Yes, that is correct.

The Court: To Nolte and Nolte?

Mr. Nakamura: That is correct. We have a copy in the file papers that, perhaps, Your Honor may be interested in seeing just what that notice of allowance looks like. I have the actual application file here.

The Court: What was mailed was presumably a carbon of that, I take it?

Mr. Nakamura: Yes, Your Honor; this is the original, and a carbon is mailed as a matter of practice.

There is one other point that I would like to make, Your Honor:

***518** In our opposition, which was filed yesterday, there is attached Exhibit B, which is the last decision of the Assistant Commissioner in this particular case.

I would like the Court to note that in the last line on the first page Commissioner Kalk says: Petitioners are apparently the only ones who have complained about not receiving a notice of allowance mailed on February 20, 1969. 331 were mailed that day.

There is just one statement that I would like to make in closing, Your Honor:

There is a reason why Assistant Commissioner Reynolds allowed the petitions in the two cases that Mrs. Sommer has mentioned. There is equally a good reason why the petition in this case was denied.

The distinction is this: If there is any positive indication in the application filed, itself, that the Patent Office may have not properly mailed a notice of allowance, then the Commissioner will grant relief. But if there is no such indication, no such positive indication of improper mailing by the Patent Office of the Patent Office application, and there is only the allegation that the applicant did not receive the notice of allowance, then relief is denied.

The Court: Your proof of mailing is the possession of the ribbon copy of the notice of allowance, which is part of your file?

Mr. Nakamura: That is correct.

The Court: The fact of mailing the notice is entered some place else?

Mr. Nakamura: Yes, it is. It is on the face of the application filed. I don't know whether Your Honor noticed that. In the lower right-hand corner there is a stamped in date of February 20, 1969.

There is a block there, I believe, that is labeled "Notice of Allowance." Date mailed: February 20, 1969. That is the date that it was mailed.

The Court: Who put that on there?

Mr. Nakamura: This would be placed on there by the issuing branch.

The Court: But they have no other record other than having put that stamp on there, is that correct?

Mr. Nakamura: Other than having kept a tally of the total number which were mailed that day, or each day, there is no record kept on specific applications.

The Court: Mr. Nakamura, is there any particular pattern about when notices of allowance are

issued?

Mr. Seward's affidavit has four cases cited, one of which has an allowance notice sent after 13 days; another one was a month and 20 days; another one was four months and 21 days; another one is eight months and three days.

With respect to one of these, they mention a status letter which was sent and brought no response. The second status letter brought a telephone call from the examiner, giving the date of allowance, stating that the application was abandoned for failure to file an issue fee. In that case a petition to review is pending.

Mr. Nakamura: In answer to your question, Your Honor, there is no period, I believe, that one can count on from notification to the mailing of the notice of allowance. It fluctuates. It depends upon the work load. It depends upon the people there that particular day; whether they have gotten behind. I am afraid that it is not a predictable figure.

The Court: What about the status letters and telephone calls?

Mr. Nakamura: Telephone calls would be answered. Status letters generally are answered. But I would not say that they are invariably answered. That would not be correct.

The Court: What would be the effect on the Department if the rule were other than requiring the notice to be mailed, but also require that it be received?

Mr. Nakamura: Then I believe that we would have to grant a petition in every case that comes into the Patent Office complaining about failure to receive notice of allowance.

The Court: How many of those have you had in the past?

Mr. Nakamura: There are probably not too many, but I would not say for sure. I can say this much; that-well, no, I don't think that is a very good estimate. I was going to say that in addition to the two cases that I handed up to you, there is one other published Commissioner's Decision that I know about. There are a few others, but they all date back to the 1920's or earlier.

The Court: Those are Patent Office Gazette reported cases?

Mr. Nakamura: That is correct.

The Court: What I was thinking about is in your normal experience does this happen very often?

There may have been some cases in situations where this has happened, and because of these decided cases they have not taken it further; or the subject matter might not have been sufficient to warrant going further. I was just wondering, as a matter of general experience, does this happen very often?

Mr. Nakamura: I am not personally experienced in this, Your Honor. But I am quite sure that there are, from time to time, cases coming up on this point. Just from casual conversation, I know this personally.

The Court: Well, I think that I have heard enough. I am going to deny the Government's ***519** motion to dismiss and grant the plaintiffs some kind of relief.

I am going to require the plaintiff to work out the form of the order with Mr. Nakamura, so that it will do the least damage to the Department's practice.

The reason why I am ruling as I am is because it is difficult for me to believe that the notice was or was not received, when these people, who have every interest in its receipt, apparently acted on the assumption that it never came.

I am perfectly willing to admit that the language of the statute and the decisions of the Patent Office are just as you stated, Mr. Nakamura.

But I think that in the rare case, such as this, that comes up, that, because of the fair administration of law by the Patent Office, it would permit these rare situations to be accommodated instead of relying on the strict letter of the statute.

So, I will charge you, Mrs. Sommer and Mr. Nakamura, to work it out and I will sign an order on it. The reason that I am requiring you to do that is because of the fact that Mr. Nakamura is with the Patent Office and he has an important position down there. I am sure that he would not agree to an order that would go further than it has to. I do not know enough about patents to take the responsibility or trust my own judgment.

Mrs. Sommer: Thank you, Your Honor.

Mr. Nakamura: I believe that I understand Your Honor.

Jan. 4, 1971

ORDER

Upon consideration of the defendant's Motion to Dismiss and the plaintiffs' Motion for Summary

Judgment and the hearing thereon, it is by the Court this 31st day of December 1970,
Ordered that (1) the defendant's Motion to Dismiss herewith is denied, (2) the plaintiffs' Motion for
Summary Judgment herewith is granted, and (3) the defendant herewith is authorized to issue a
notice of allowance in plaintiffs' patent application Serial No. 513,380, in suit.

D.D.C.

172 U.S.P.Q. 513

END OF DOCUMENT

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